

**IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE**

INVENTOR(S): Smith et al.

APPEAL NO.: 2007-3103

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EXAMINER: C. Park

TITLE: SYSTEM FOR PRINTING A DOCUMENT WITH RECURRING IMAGES

**REQUEST FOR REHEARING OF THE DECISION ON APPEAL DATED
JANUARY 7, 2008 AND SUPPORTING ARGUMENTS
(Pursuant To Rule 41.52)**

Applicants/Appellants request rehearing of the Decision on Appeal entered January 7, 2008 to allow the Board to reconsider the new grounds for rejection entered against Claims 1, 8, 10 and 14.

The Board reversed the rejections based on Suzuki (5923013) and Shimuzu (6052202) but entered new grounds rejecting Claims 1, 8, 10 and 14. The Board did not express any view on the patentability of the other pending claims, leaving that determination to the discretion of the Examiner.

Thus, Claims 1, 8, 10 and 14 stand rejected under Section 103 as being obvious over Tsunekawa 6734989. For the reasons detailed below, Applicants respectfully traverse the Board's finding of obviousness.

Claims 1, 8, 10 and 14 each recite limitations related to processing images that occur more than once in a document according to different printing techniques, depending on which technique is indicated. For example, Claim 1 recites a means for:

(1) responding to the indicator indicating permission is granted to print each

instance of the form from the same video data by processing and printing the named sequence according to a first printing algorithm; and

(2) responding to the indicator indicating each instance of the form is to be printed from new video data by processing and printing the named sequence according to a second printing algorithm.

Tsunekawa, by contrast, deals exclusively with printing each instance of a form from saved data -- in the language of Claim 1, for example, printing each instance of the form from the "same" video data. So far as Applicants can tell, Tsunekawa does not suggest any kind of an indicator for printing from new video data or the same video data, or even that each instance of the form might somehow be printed with new video data.

The relevant disclosures in Tsunekawa are summed up nicely at column 16, lines 12-21, as follows:

In accordance with the present invention, as described above, raster data is generated from form data, encoded and stored. When a form print instruction is received, the stored form data is decoded and developed as image data. This makes it possible to finish drawing processing at high speed regardless of the content of the form data. In particular, in a case where an ordinary page to be combined with the form data of a single form differs for every page, the time needed to generate form data from the second page onward can be made zero.¹

The Board interprets Tsunekawa as teaching "multiple modes of operation" and concludes, therefrom, that "the claimed processing of the named sequence based on alternate algorithms selected through the indicator would have been obvious in view of Tsunekawa." The Board, however, offers no reason the ordinarily skilled artisan would be prompted to modify Tsunekawa in the way claimed. See *KSR Int'l Co. v. Teleflex, Inc.* 550 U.S. ___, 127 S. Ct. 1727 (April 30, 2007) (pages 15-16 of the Bench Opinion). There are no multiple modes of operation in Tsunekawa -- once a form is stored, each instance of the form is thereafter printed from the saved data. And, this procedure is followed whether or not the form data has already been stored as raster data (so-called

¹ For detailed disclosures, see Tsunekawa column 4, lines 60-67; column 5, lines 49-58; column 7, lines 2-47; column 8, lines 1-9 and 23-30, column 9, lines 14-20 and 39-44; and column 10, lines 8-37.

"form image data" -- Tsunekawa column 7, lines 16-17).

For Claim 1, Tsunekawa does not disclose first and second printing algorithms generally, and specifically not first and second printing algorithms for printing each instance of a form from the same data or from new data. Tsunekawa also does not disclose an indicator indicating permission to print each instance of a form according to the first algorithm (printing each instance from the same data) or the second algorithm (printing each instance of the form from new data). In fact, Tsunekawa doesn't disclose that each instance of a form is ever printed from new data.

For Claims 8 and 10, Tsunekawa does not disclose a parameter that may have first and second values each indicating permission to print each instance of a form from the same data or from new data, nor does Tsunekawa disclose responding to any parameter of any value by generating new data to print each instance of the form.

For Claim 14, Tsunekawa does not disclose, *within a plurality of commands describing a document*, (or anywhere else) at least one command indicating permission is granted to convert the named sequence once into video data and to then print each instance of the form from the video data or at least one command indicating new video data is to be generated to print each instance of the form. The Board's remarks do not address the italicized limitation from Claim 14. Again, so far as Applicants can tell there is nothing in Tsunekawa that even remotely suggests commands describing a document that include either video data command recited in Claim 14.

Applicants respectfully submit that these substantial differences between the claimed subject matter and the cited art would not have been obvious to the ordinarily skilled artisan familiar with the teachings of Tsunekawa, at least not without also having had the benefit of reading the present Application. The differences between the prior art of Tsunekawa and the claimed subject matter are just too great. If the Board disagrees, it is respectfully requested to more specifically point out and explain (1) how it is that the printing techniques disclosed in Tsunekawa might be modified to reach the subject matter of each of Claims 1, 8, 10, and 14 and (2) the reason an ordinarily skilled artisan would be prompted to make any such modifications. Absent such a showing, Applicants respectfully submit that the obviousness rejection should be withdrawn.

Respectfully submitted,

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